

Appl. No.: 09/827,196
Response dated May 22, 2003
Office Action 2/26/03

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REMARKS

Objection to the specification

Applicant has amended the specification to delete the reference to drawings. Withdrawal of the objection is respectfully requested.

Claim Rejections Section 112, first paragraph

The Action rejects the claims under Section 112, first paragraph for containing subject matter that is not in the specification to enable a skilled artisan to make and use the invention. Specifically, claims 10 and 21 are rejected for need of clarification regarding monomers and polymers, claims 11-22 are rejected for lack of non-anhydrous fillers; and claim 12 not enabling moisture containing fillers. Applicant respectfully traverses this rejection.

Claims 10, and 21, have been amended to provide the required clarification. Claims 11 and 12 are enabled as structural fillers are known to contain moisture, the present invention is based on the recognition that either anhydrous and non-anhydrous structural fillers are useful with the present invention. Non-anhydrous structural fillers find support in the claims and throughout the specification because they provide, alone or in combination with water, the moisture required to cure the moisture curable monomers into a polymer, see paragraph [0020]:

[0020] The present invention is based on the recognition that the addition of two essential ingredients, namely a filler or grout creating material, e.g., Portland cement and a moisture curable polymer may be stored in substantially anhydrous conditions and used, instantly by merely providing a free radical catalyst, e.g., water. The polymer-grout composition is capable of developing sufficient compressive strength and ideal setting characteristics that address the functional requirements of settings involving new construction or repair. Furthermore, the grout composition may include a significant proportion of Portland cement without affecting the performance of the grout composition.

Applicants believe that the claims as amended address each and every ground for rejection and respectfully request withdrawal of all pending rejections under 35 U.S.C. §112, first paragraph.

Claim Rejections Section 112, second paragraph

The Action rejects the claims 1-22 under Section 112, second paragraph for being indefinite because the "meaning of 'structural fillers' is not known."

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It is well established that an applicant, within reason, can be their own lexicographer, that is, he or she may create or use whatever terms they may choose to define their invention, so long as they don't contradict accepted terms in the art. In re Swinehart, 439 F.2d 210, 160 U.S.P.Q. 226 (C.C.P.A. 1971). Furthermore, this inquiry is undertaken in light of the content of the specification, the teachings of the prior art, and the claim interpretation that would be given to the plain language of the claims in light of the specification by one of skill in the art. In re Wiggins, 488 F.2d 538, 170 U.S.P.Q. 421 (C.C.P.A. 1973).

The specification in paragraphs [0001], [0010], [0011], [0012] and [0020] (incorporated herein by reference) teach that structural fillers, when combined with polymer forming moisture curable monomers, are capable of creating a solid cement polymer matrix whereby each of the components provide structural support to the combined matrix to fill large gaps in new construction and repair that will be exposed to water. As stated in paragraph [0011], the skilled artisan would recognize that structural fillers are those fillers with, "sufficiently high solid content that enables crosslinking of both the monomers that form the structural matrix, but also the polymer matrix formed by the filler." The Applicant believes that all pending claims are therefore allowable and Applicants respectfully request withdrawal of all pending rejections.

Claim Rejections Sections 102/103

The Action rejects claims 1-22 under 35 U.S.C. § 102 and/or obvious under 35 U.S.C. § 103, over Shearing 3,763,070; Shearing 3,772,051; Shearing 3,977,889; Alexander 4,127,548; Kozzatz, et al. 4,902,348; Tsai et al. 5,807,431 or Laas, et al. 6,007,619, in view of Ikemoto, et al. 5,932,344. The claims as amended are believed to overcome the rejections. The claims as amended are believed to overcome the rejections as each and every reference cited discloses a hydraulic cement, that is, a water containing cement. The Applicant believes that all pending claims are therefore allowable and Applicants respectfully request withdrawal of all pending rejections.

Further Claim Rejections under Sections 102/103

The Action rejects claims 1-22 under 35 U.S.C. § 102 and/or obvious under 35 U.S.C. § 103 over Szukiewicz 2,902,388; Shearing 4,211,680; Stark, et al. 5,021,537; Abdelazig, et al. 5,326,396; von Bonin 5,374,448 or Toray Ind. JP-9-302239 in view of Ikemoto, et al. 5,392,344.

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The claims as amended are believed to overcome the rejections as each and every reference cited discloses a hydraulic cement in the form of a water containing cement. At most, the cited references establish that it might be "obvious to try" various combinations of ingredients. However, "obvious to try" is not the standard for patentability under 35 U.S.C. § 103. The Federal Circuit has stated:

In some cases, what would have been "obvious to try" would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were crucial or no direction as to which of many possible choices is likely to be successful. [citing cases]

... In others, what was "obvious to try" was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the invention or how to achieve it.

In re O'Farrell, 7 U.S.P.Q.2d 1673, 1681 (Fed. Cir. 1988). Both "obvious to try" situations arise here. The Examiner has cited patents with disclosures too broad to render Applicants' specific combination obvious, and has proposed a modification to one of the ingredients in one of the steps based only on a very generalized motivation of seeking the desired final product. There is no teaching, suggestion or motivation for providing, e.g., a kit with containers having the present components and instructions for their application. Likewise, the art cited teaches away from the current components, namely, providing components having an extended shelf-life that will not harden until the user mixes the two components. The art cited teaches uses, a hydraulic cement that is mixed with epoxies and/or heated (Shearing patents, Stark, von Bonin, Tsai, Laas, Minami), is pressurized (Kozzatz) and/or does not provide the claimed structural support (Abdelrazig, Laas) to provide for filling or gaps in daily applications for tile grouting in, e.g., bathrooms. The present invention requires no such heating, pressure and/or moisture in the packaging, thereby avoiding the problems in the prior art. Furthermore, the components may be dry-mixed to provide the filler compound that hardens with exposure to moisture and stepwise instructions for solving the problem identified. Lacking proper support for a motivation, teaching or suggestion that one or more the components by provided to practice the present invention, Applicant respectfully requests a showing of such motivation or withdrawal of the extant rejection. Finally, regarding the Japanese Application, the abstract provided does not

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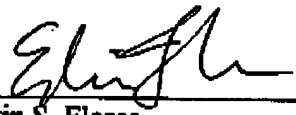
teach or enable practice of the present invention. The teaching of cement, as used in the art would include water, however, lacking an adequate translation of the entire patent document, the Japanese patent document is insufficient to be used as enabling prior art and should be withdrawn or an appropriate translation provided to support the rejection. The Applicant believes that all pending claims are therefore allowable and Applicants respectfully request withdrawal of all pending rejections.

No additional claims' fees are believed to be due as a result of the addition of the new claims or this Response. The Examiner is invited to telephone the undersigned at the telephone number listed below if he or she has any questions or suggested amendments to the claims.

Dated this May 22, 2003.

Respectfully submitted,

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